UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,471	10/31/2005	Zino Lee	1508-7 PCT/US	4067

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/555,471	LEE, ZINO
	Examiner	Art Unit	
	JAMES ZURITA	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 October 2005</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-9</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

Priority

The instant application is a national stage entry of PCT/KR04/01013,

International Filing Date of 04/30/2004, which claims foreign priority to 10-2003-

0027938, filed 05/01/2003. The application was published on 11/11/2004 as WO

2004097662A1.

Information Disclosure Statement

The information disclosure statement filed 10/31/2005 fails to comply with 37

CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it

is presently understood by the individual designated in 37 CFR 1.56(c) most

knowledgeable about the content of the information, of each patent listed that is not in

the English language. It has been placed in the application file, but the information

referred to therein has not been considered.

The IDS mentions application KR20-301693Y, filed 01/08/03 in Korea. Applicant

has not provided an English translation of this document.

Claim Objections

Claims 1-9 are objected to because of the following informalities:

The claims refer to first level, second level, third level and fourth level.

The figures refer to level 0, level 1, level 2 and level 3.

Claim 6 reads, in part, "…[providing a return path management *system*]

…determined to be delivered to the provider *system* belonging to a first level, the

[which?] system identifies…" It is not clear which system is being referred to.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claims 1-4, 6 and 7 contain the term or [*if* statements] and *"…depending on…"*

The term renders the claims indefinite, since it is not possible to determine the scope of

the claim as requiring both items or only one of the items separated by the or. For

purposes of this examination, examiner will give the term its broadest reasonable

interpretation and consider that the particular condition is satisfied if one of the

limitations is met.

Claims 1-9 refer to user authentication. The disclosures also refer to user

authentication but do not elaborate as to what constitutes user authentication.

Claims 1-9 are generally narrative and indefinite, failing to conform with current

U.S. practice. They appear to be a literal translation into English from a foreign

document and are replete with grammatical and idiomatic errors. At times, it is not

possible to determine the metes and bounds of the claims, and what is specifically

being claimed. For example, claim 2 and 7 refer to ...a billing processing...and...a

billing processing information...

> ...perform a billing processing...delivers *a user authentication information* and *a billing processing information* in combination with the received order information to the provider system in a packetized form, and updates the content database referring to contents received from the provider system...

Claims 2, 5, 7 and 9 refer to update[...] content database, and it is not clear what

is being updated, and when the updating takes place:

> ...updates the content database referring to contents received from the provider system. (claims 2 and 7)
> ...an update of contents is performed referring to the content database (claims 5 and 9).

Claims 1-4 and 6-8 refer to delivering/communicating *order information* in

packet[...], encapsulated packet and packetized form to provider. Fig. shows that

service level, destination URL, user authentication information, billing processing

information, other order information and application-related information are not part of

the encapsulated packet.

Claims 1-9 refer to ordering, order information. The disclosures refer to delivery

of goods and services, and show that order acknowledgement information is sent from

reference 600 to a user. Thus, there is no delivery shown for any goods ordered. The

disclosures support delivery of digital goods, not physical goods.

Claims 1-9 refer to **packet**[...] as follows:

> communication packetization, Claims 1 and 6
> communication packet, claim 3, four times
> encapsulated packet of the order information, claim 3, three times
> packetized form, claims 1, 2 and 7

It is not clear what is contained in a packet, and what Applicant considers an

encapsulated packet. Thus, it is not possible to determine the metes and bounds of the

claims. Further, the Examiner notes that communications over the Internet inherently

involve packets, as in TCP/IP.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title,
>   *if* the differences between the subject matter sought to be patented and the prior art are such
> that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gerzberg et al. (US 6,452,923) in view of Official Notice.

As per claim 1, Gerzberg discloses return path management method(s) and

system(s) for managing return paths from user televisions to provider systems (CATV,

as in Fig. 1E and related text) in packetized form (the Internet, as in col. 1, lines 24-34);

As per claim 1, Gerzberg discloses a return path management system which

delivers return paths from user televisions (Fig. 1E, CATV) to provider systems in a

Packetized form,

comprising a return path server, a provider database, a user database and a

content database (e.g., col. 33, lines 48-67),

wherein the provider database maintains providers information (col. 7, lines 8-26) depending on levels which the provider systems belong to and which determine service levels,

the user database maintains users information required for users authentication, a content database maintains contents information provided from the provider systems, and the return path server receives order information, identifies a provider to whom the received order information should be delivered, determines a service level based on the level which the provider belongs to in reference to the provider database, and performs interpretation and packetization of the order information depending on the determined service level.

As per claim 1, Gerzberg does not specifically disclose the number of servers and databases claimed. Official Notice is taken that the Internet is a network of multiple physical and logical servers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gerzberg and knowledge common to those of ordinary skill in the art to disclose, as per claim 1, a return path server, a provider database, a user database and a content database because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

As per claim 2, Gerzberg discloses the return path management system as set forth in claim 1, wherein the provider database maintains the providers information by categorizing each of the provider systems into any one of four levels based on the service level requested from the provider, and the return path server identifies the

provider and determines the service level referring to the received order information and

the provider database, and then,

if the user's order is determined to be delivered to the provider system belonging

to a first level, the return path server identifies an URL address of the provider system

from the order information and delivers the received order information to the provider

system in a Packetized form,

if the user's order is determined to be delivered to the provider system belonging

to a second level, the return path server performs a user authentication referring to the

order information and the user database, and delivers a user authentication information

in combination with the received order information to the provider system in a

Packetized form,

if the user's order is determined to be delivered to the provider system belonging

to a third level, the return path server performs a user authentication referring to the

order information and the user database, extracts a billing information (see, e.g., Fig. 31

and related text concerning billing features) from the order information (e.g., Fig. 2 and

related text) to perform a billing processing in contact with a financial server as a

representative of the provider (e.g., col. 11, lines 31-50), and delivers a user

authentication information and a billing processing information in combination with the

received order information to the provider system in a packetized form (e.g., via the

Internet), or

if the user's order is determined to be delivered to the provider system belonging

to a fourth level, the return path server performs a user authentication referring to the

order information and the user database, extracts a billing information from the order

information to perform a billing processing in contact with a financial server as a

representative of the provider, delivers a user authentication information and a billing

processing information in combination with the received order information to the

provider system in a Packetized form, and updates the content database referring to

contents received from the provider system.

As per claim 3, Gerzberg discloses the return path management system as set

forth in claim 2, containing service levels (e.g., Abstract)

if the user's order is determined to be delivered to the provider system belonging

to a first level, a packetized communication delivered from the return path management

system to the provider system contains a service level of the provider, a destination

uniform resource locator (URL) of the provider system and an Encapsulated order

information;

if the user's order is determined to be delivered to the provider system belonging

to a second level, a packetized communication delivered from the return path

management system to the provider system contains a service level of the provider, a

destination URL of the provider system, a user identification information and an

Encapsulated order information;

if the user's order is determined to be delivered to the provider system belonging

to a third level, a packetized communication delivered from the return path management

system to the provider system contains a service level of the provider, a destination

URL of the provider system, a user identification information, a billing-processing

information and an Encapsulated order information (see, e.g., Fig. 31 and related text

concerning billing features); and

if the user's order is determined to be delivered to the provider system belonging

to a fourth level, a packetized communication delivered from the return path

management system to the provider system contains a service level of the provider, a

destination URL of the provider system, a user identification information, a billing-

processing information, other order-related information and application-related

information.

As per claim 4, Gerzberg discloses the return path management system as set

forth in claim 1, wherein the return path management system has a hierarchy structure

such that determination of the service level to the order information received from the

user and processing of communication packets delivered from the return path

management system to the provider system are separately performed (e.g., col. 2, line

58-col. 3, line5).

As per claim 5, Gerzberg does not specifically disclose the number of servers

claimed. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Gerzberg and knowledge common to those of ordinary

skill in the art to disclose, as per claim 5,

> the return path management system as set forth in claim 4, comprising a return
> path server and four transaction servers coupled to the return path server wherein the
> return path server receives an order information from the user, identifies the provider
> system to which the order information is required to be delivered and determines the level
> to which the identified provider system belongs, referring to the provider system, and
> a first transaction server of the four transaction servers treats the order
> information to be delivered to the provider system belonging to a first level,
> a second transaction server of the four transaction servers treats the order
> information to be delivered to the provider system belonging to a second level in which a
> user authentication is performed referring to the user database,

a third transaction server of the four transaction servers treats the order
information to be delivered to the provider system belonging to a third level in which a
user authentication is performed referring to the user database and a billing processing is
performed in contact with a financial server, and

a fourth transaction server of the four transaction servers treats the order
information to be delivered to the provider system belonging to a fourth level in which a
user authentication is performed referring to the user database, a billing processing is
performed in contact with a financial server, and an update of contents is performed
referring to the content database,

because the incorporation of such features is no more than the predictable use of

prior art elements according to their established function.

Claim 6 is rejected on the same grounds as claim 1.

Claim 7 is rejected on the same grounds as claim 2.

Claim 8 is rejected on the same grounds as claim 4.

Claim 9 is rejected on the same grounds as claim 5.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Levinson, US 7,222,358

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JAMES ZURITA whose telephone number is (571)272-

6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
James Zurita
Primary Examiner
Art Unit 3625